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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,550	12/26/2001	Katsuhiko Suzuki	H07-138280M/NHK	8312

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McGinn & Gibb, PLLC
Suite 200
8321 Old Courthouse Road
Vienna, VA 22182-3817

EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/025,550

Applicant(s)

SUZUKI ET AL.

Examiner

Janis L. Dote

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1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment, paragraph 1 and 2.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment paragraph 3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-10.

Claim(s) withdrawn from consideration: 11-20. acceptable.

8. ☒ The drawing, ^{correction} filed on 11/24/03 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: attachment and PTO-892

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700

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1. The proposed "amendment to the claims" filed after the final rejection on Nov. 24, 2003 (Amdt112403) is considered to be non-compliant because it fails to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003).

In claims 16-20, labeled "withdrawn," the word "apparatus" in the phrase "image forming apparatus of claim . . .," which was previously recited in claims 16-20 filed on Jun. 6, 2003 (Amdt060603), has been merely replaced with the word -- method --, without the proper markings. Applicants have improperly amended claims 16-20. In addition, applicants have not properly identified claims 16-20 as "withdrawn - currently amended."

37 CFR 1.121(a)(2) reads: "[w]hen claim text with markings is required. All claims being currently amended shall . . . be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters" (emphasis added).

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2. Proposed amended claims 1 and 2 filed in Amdt112403 raise new issues because the limitation "said shape coefficient SF2 is selected to provide a desired toner fluidity between said first and second developing rollers" was not present in the claims when the final rejection was mailed on Aug. 22, 2003 (CTFR060603). In addition, the limitation appears to raise the issue of new matter. The originally filed specification at page 20, line 23, to page 21, line 10, discloses that "when the toners pass through the developing agent distributing member 8 and through between the developing rollers 61, 62, due to the poor fluidity of the toners, the stress to be applied to the developing agent becomes excessively large . . . in the case where stress becomes excessively large, the spent [toners fused and adhered to the magnetic carrier surfaces] occurrence speed increases." The specification at page 21, lines 5-9, discloses that large toner spent gives rise to the occurrence of photographic fog. In other words, the specification appears to disclose that the "poor fluidity of the toner" increases the "stress" applied to the developing agent as the developing agent passes through the "developing agent distributing member 8 and through between the developing rollers 61, 62" (emphasis added), which

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thereby increases toner spent. The specification does not disclose that the toners have a "desired fluidity" between the first and second developing rollers" as recited in amended claims 1 and 2.

Proposed amended claims 3, 4, 7, and 8 filed in Amdt112403 further raise new issues because the limitation "peripheral speed ratio S1 is in a range from 0.9 to 1.9" recited in amended claims 3 and 7, and the limitation "peripheral speed ratio S2 is in a range from 1.1 to 1.9" recited in amended claims 4 and 8, were not present in the claims when the final rejection CTFR082203 was mailed.

Proposed amended claims 6 and 10, reciting the limitation that carrier includes "one of iron-powder-system carriers, ferrite-system carriers, and magnetite-system carriers" (emphasis in the original), raise a rejection under 35 USC 112, second paragraph, because it is not clear whether applicants intend for the magnetic carrier to include one of each of the three recited compositions or only one.

Proposed amended claims 4 and 9, and proposed amended claims 6 and 10, also raise the issue of new matter for the reasons discussed in the final rejection CTFR060603, paragraph 8, items (4) and (5), respectively.

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3. The examiner's refusal to enter the amendment filed after the final rejection (Amdt112403) renders applicants' arguments regarding said amendment moot.

Furthermore, the 35 USC 112, first paragraph, rejection of claims 1 and 2, with respect to the lack of adequate written description of the limitation "magnetic developing agent including toners and magnetic carriers" (emphasis added), stands for the reasons set forth in CTFR060603, paragraph 8, item (1). As discussed in the rejection, the originally filed specification discloses a developing agent "consisting mainly of toner and magnetic carrier." The term "mainly" is an adverb, which is usually defined as "chiefly; principally; or in the main." See Webster's New World Dictionary, 3rd College Edition, page 815. The adverb modifies the term "consisting." The originally filed specification does not state that the developing agent "includes toners and magnetic carriers as main ingredients" as asserted by applicants. Moreover, if the phrase "consisting mainly of toners and magnetic carriers" means that the developing agent comprises toners and magnetic carriers as the "main" ingredients, the limitation "including toner and magnetic carrier" is still

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broader than the disclosure in the originally filed specification, because it includes developing agents that do not comprise toners and magnetic carriers as "main" ingredients.

Furthermore, applicants' arguments with respect to the rejection over the combined teachings of Anzai and JP'338 are not persuasive for the reasons discussed in the final rejection CTFR060603, paragraph 12. Applicants' arguments with respect to the lack of motivation to combine the teachings of the references have been addressed in CTFR060603 at pages 15-17.

Accordingly, the instant claims stand rejected for the reasons set forth discussed above and in the final rejection CTFR060603.